



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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FEB 10 2003

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading her answers to question 2, 12, 15, and 29 of the morning section and question 9 of the afternoon section of the Registration Examination held on April 17, 2002. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On August 5, 2002 petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has not been awarded an additional points for morning questions 2, 15, and 29 or for afternoon question 9. Petitioner has been awarded an additional point for morning question 12. Accordingly, petitioner has been granted one additional point on the Examination. Petitioner's arguments for these questions are addressed individually below.

Morning question 2 reads as follows:

2. Registered practitioner Pete received on September 13, 2001 a notice of allowance dated September 10, 2001 in a utility application filed December 5, 2000. The client for whom the application is being prosecuted has repeatedly stressed to counsel how valuable the invention is, and that it will remain so throughout the entire life of any patent that should issue. Pete is determined to take no chances with this application, particularly since patent term adjustment has been accumulated and the lack of any action or inaction by applicant that would cause loss of patent term adjustment. Thus, Pete is ready to pay the issue fee on the very day the Notice of Issue Fee Due is received. Before payment of the issue fee, the client faxes Pete information identifies prior art first cited on September 3, 2001 by the foreign office examining a foreign counterpart application. This prior art was not previously cited by another foreign patent office. The invention had been filed

with a second foreign office that mailed the same prior art at a later date than the first foreign office. Also, this prior art was previously unknown to the client. The client is very desirous of having this cited art made of record in the file. Which of the following alternatives would best achieve the client's objectives of maximizing patent term and having the foreign cited prior art considered by the USPTO?

(A) Pete should file a petition for withdrawal from issue of the allowed application for consideration of a request for continued examination based on an information disclosure statement (IDS) and include in the petition an offer to file the request and IDS upon the petition being granted.

(B) As it is still within three months from the date cited by the foreign office, Pete can submit the prior art in the allowed application up to the last day of the three month period making any required statements and fee payments.

(C) Pete should submit an IDS citing the prior art in the allowed application within 30 days of the September 3, 2001 mailing by the foreign office with any appropriate fees and statements.

(D) If, Pete could use the date of mailing by the second foreign office to file the IDS in the allowed application within three months of the communication of prior art by the second foreign office thereby allowing the client extra time to evaluate the allowed claims and still have the IDS entered.

(E) (B) and (D).

2. The model answer: (C) is the correct answer. 37 C.F.R. § 1.704(d) provides that submission of an information disclosure statement under §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) under 37 C.F.R. § 1.704(c)(10) (submission of a paper after a notice of allowance) if the communication was not received by any individual designated in 37 C.F.R. § 1.56 more than thirty days prior to the filing of the information disclosure statement. Submission of the information disclosure statement to the USPTO within 30 days from mailing by the foreign office would inherently meet the 30 day requirement for submission to the USPTO from receipt by a 37 C.F.R. § 1.56 party of the information from the foreign office. Meeting the 30 day period for filing the information disclosure statement after allowance will prevent a reduction of the patent term adjustment already accumulated. Answer (A) is not the best answer. A request for continued examination will delay the issuance of the patent over permitting the original application to issue with the information disclosure statement filed, pursuant to answer (A), thereby causing loss of a portion of the 20 year term as the patent term is measured from the earliest priority date claimed, 35 U.S.C. § 154(a)(2). Answer (B) is not the best answer. Complying with the three month period requirements under 37 C.F.R. § 1.97(d) will permit the information disclosure statement to be considered in the allowed application without the need to withdraw from issue and refile. Answer (B) provides that the information

disclosure statement can be submitted up to the end of the three month period, which means that the 30 day period of 37 C.F.R. § 1.704(d) may not be met and a reduction in the accumulated adjustment period may result. Answer (D) is not correct. 37 C.F.R. § 1.97(e) provides that the three month period is to be measured from when information submitted in an information disclosure statement was first cited by a foreign office. A later second cite by another foreign office cannot be used to measure the three month period. Answer (E) is not the best answer as answer (B) is not the best answer and answer (D) is not correct.

Petitioner argues that answer choice (B) is correct. Petitioner contends that answer (B) is correct and the model answer is flawed because more than one answer can best achieve the client's objective. Petitioner argues that the wording of Candidate's answer choice (B) allows Peter Practitioner to submit the prior art without delaying prosecution.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer choice (B) is as correct as answer choice (C), the correct answer is answer choice (C).. Question 2 asks which answer would best achieve the client's objective of maximizing patent term adjustment and having the foreign prior art considered by the USPTO. Answer choice (B) would not achieve the goal of maximizing patent term adjustment because the applicant would receive a reduction for submission of prior art after the mailing of the notice of allowance, a violation of 37 CFR 1.704(c)(10). Accordingly, answer (B) would only achieve the goal of consideration by the USPTO pursuant to 37 CFR 1.97(e). On the other hand, answer choice (C) would achieve both goals because the Office would consider the prior art pursuant to 37 CFR 1.97(e) and the Office would maximize the patent term adjustment because the submission of the prior art with a statement meeting the requirements of 37 CFR 1.704(d) would not be considered a failure to engage in reasonable efforts to conclude prosecution of the application under 37 CFR 1.704(c)(10) and therefore not a reduction against any earned patent term adjustment. Accordingly, model answer choice (C) is correct and petitioner's answer choice (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 12

12. Applicant has been awarded an additional point for answer choice (D).

Morning question 15 reads as follows:

15. Able is a registered solo practitioner. Ben asks Able to prepare and prosecute an application for a utility patent. As part of the application, Able prepares a declaration and power of attorney, which Ben reviews and signs. Able files the application, the declaration, and power of attorney with the USPTO. Able quickly recognizes that help is necessary and contacts another registered practitioner, Chris, who often assists Able in such instances. Able, with Ben's consent, sends a proper associate power of attorney to the Office for Ben's application and directs that correspondence be sent to Chris. The

examiner in the application takes up the application in the regular course of examination and sends out a rejection in an Office action. Chris sends a copy of the action to Ben to obtain Ben's comments on a proposed response. Unfortunately, after the first Office action, Able becomes terminally ill and dies. Ben does not know what to do, so Ben calls the examiner at the number on the Office action and explains that A died and Ben is worried how to proceed. Which of the following statement(s) is/are true?

(A) Chris should inform Ben that the Office will not correspond with both the registered representative and the applicant and therefore, Ben should not have any further contact with the Office and let Chris send in a proper response.

(B) Ben should send in a new power of attorney for anyone Ben intends to represent him before the Office.

(C) Ben should execute and send to the USPTO a new power of attorney for any registered patent practitioner that Ben intends to have represent him before the Office.

(D) (B) and (C).

(E) None of the above.

15. The model answer: (C). MPEP § 406. Answer (C) is a true statement because the Ben may appoint a registered practitioner to represent him. Answer (A) is incorrect because the power of a principal attorney will be revoked or terminated by his or her death. Such a revocation or termination of the power of the principal attorney will also terminate the power of those appointed by the principal attorney. Therefore, Chris's associate power of attorney is revoked and Chris cannot continue representing Ben without a new power of attorney from Ben. Furthermore, the Office will send correspondence to both Chris and Ben in the event of notification of Able's death. (B) is not the best answer because it suggests Ben may appoint a non-practitioner to prosecute the application and because it does not require the power of attorney to be executed (*cf.* answer (C)). (D) is not the best answer because it includes (B). (E) is false because (C) is true.

Petitioner argues that answer (D) is correct. Petitioner contends that the model answer choice (C) is not the best choice because answer choice (B) is also a correct choice and accordingly, the correct answer would be D. Petitioner argues that the model answer analysis is flawed for three reasons: 1) the question does not ask which answer is the best; 2) The model answer forces candidate to presume that "anyone Ben intends" would include non-registered practitioners; and 3) model answer suggest that answer choice (B) does not require the power of attorney to be executed.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer choice (D) would be the correct answer, the correct answer choice (C) is the correct answer. Answer (B) is not a correct answer because the phrase "anyone B intends to represent him" would include non-registered

practitioners who do not have any authority to act. Because answer choice B is not correct, answer choice (D) which says that both answers (B) and (C) are correct would be incorrect as well.

Petitioner's assertion that the question does not require the best answer but only a correct answer is not accurate. Note that the directions expressly require that only one answer is the most correct. Petitioner is required to find the most correct answer. In addition, petitioner's assertion that since "Ben reviewed and signed the first declaration and power of attorney, thus Ben is imputed to have the knowledge of reviewing, signing and filing a proper power of attorney" is an assumption that the directions warns against. Note that the directions expressly advise petitioner not to assume any additional facts not presented in the questions. Moreover, petitioner's assertion that the model answer is flawed because it suggest that answer choice (B) does not expressly require the execution of the power of attorney is also not considered persuasive because the model answer does not mention that the declaration must be executed. Note that answer choice (C) does expressly mention that Ben should execute the declaration. Accordingly, upon review of the choices petitioner must see that answer choice B would not require that the declaration be execute while answer choice (C) would require that the submitted declaration be executed.. Accordingly, model answer choice (C) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning questions 27 through 29 are based on the following factual background. Consider morning questions 27 through 29 independently of each other.

James Salt developed an environmentally friendly technique for controlling deer overpopulation. Briefly, Salt discovered a non- hormonal substance XYZ ("Antiagra") that efficiently suppresses sexual function in male deer with minimal side effects. Salt determined that the use of a non- hormonal substance eliminated adverse long-term health effects that may be experienced with hormonal substances. He then dissolved an effective amount of Antiagra in salt water, poured the resulting solution into a plurality of twenty-gallon tubs, and heated the tubs to evaporate the water. The resulting blocks of salt, throughout which Antiagra was evenly disbursed, were distributed in overpopulated areas during deer mating season to serve as salt licks. Stags that used the salt lick show no interest in mating, thereby lowering the pregnancy rate among does and helping to control the deer population. Salt has retained you to conduct a prior art search and, if appropriate, prepare and file a patent application. The only relevant prior art located during the prior art search is a patent to Deere that discloses a salt lick on which a hormonal substance is sprayed. A doe that uses the salt lick ingests the hormonal substance which, in turn, suppresses ovulation and thereby reduces the pregnancy rate. You prepare and file a patent application that provides a fully enabling disclosure and includes four claims sets. Claims 1-5 are directed specifically to the non-hormonal substance (Antiagra), claims 6-9 are directed to a salt lick laced with a non-hormonal

substance that, when ingested by a male deer, suppresses sexual function in the male deer, claims 9-14 are directed to the method of forming the salt lick, and claims 14-20 are directed to a method for controlling deer population by distributing salt licks that are treated with an effective amount of XYZ to reduce pregnancy rates. You also properly establish small entity status on behalf of Salt at the time the application is filed.

Morning question 29 reads as follows:

29. Claim 15 of the application reads: "A method for reducing pregnancy rate in wild deer population comprising the step of placing at least one salt lick containing an effective amount of XYZ in a location accessible to wild male deer so that XYZ is ingested by said male deer." The specification provides adequate disclosure as to what constitutes an "effective amount" of XYZ. In addition to the Deere patent, the examiner locates a prior art patent to John Doe that discloses the non- hormonal substance XYZ for use as a softening agent in skin cream. There is no disclosure or suggestion in the Doe patent of any other potential use for XYZ. Which of the following statements is most consistent with proper USPTO practice and procedure?

(A) The Examiner may properly reject claim 15 under 35 U.S.C. § 103 as being obvious over Deere in view of Doe because Deere teaches the method of distributing salt licks treated with a substance to reduce pregnancy rates and suppression of sexual activity in male deer is merely an inherent characteristic of a known substance XYZ.

(B) The examiner may not rely on the Doe patent in a 35 U.S.C. § 103 obviousness rejection because there is no evidence that Salt was aware of its teachings at the time the invention was made and therefore the invention could not have been obvious to Salt at that time.

(C) The examiner may rely on the Doe patent in making an obviousness rejection under 35 U.S.C. § 103 only if the Doe patent is in the field of Salt's endeavor or, if not in that field, then reasonably pertinent to the problem with which Salt was concerned.

(D) The examiner may properly reject claim 15 under the first paragraph of 35 U.S.C. § 112 because the specification is inadequate to enable a person skilled in the art to which it pertains to practice the invention.

(E) The examiner may properly reject claim 15 under the second paragraph of 35 U.S.C. § 112 because the recitation of "an effective amount of XYZ" renders the claim indefinite.

29. The model answer: The best answer is (C). MPEP § 2141.01(a). Answer A is incorrect because under the facts of the question there is no teaching or suggestion to combine the teachings of Deere and Doe. Moreover, what is inherent is not necessarily obvious. Answer B is incorrect because the test under § 103 is whether the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. The test is not whether it would have been obvious to the inventor.

Answer (D) is incorrect at least because the background facts specifically state that the specification is fully enabling. Similarly, Answer (E) is incorrect because the question specifically states that the specification provides adequate disclosure as to what constitutes an “effective amount” of XYZ.

Petitioner argues that answer (E) is correct. Petitioner contends that answer (E) is as correct as answer (C) and accordingly answer (E) should be accepted as an alternative correct answer. Petitioner asserts that answer (E) is correct because the phrase “effective amount” does not particularly point out and distinctly claim the subject matter whether or not the specification supports the definition of “effective amount”

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that the language is indefinite under 35 USC 112, second paragraph, the Board of Patent Appeals and Interferences has held that the term “effective amount” is definite when read in light of the supporting disclosure and in absence of any prior art which would give rise to uncertainty about the scope of the claim. See Ex parte Skulballa, 12 USPQ2d 1570 (Bd. Pat App. & Inter. 1989). Because the question expressly states that the specification provides adequate disclosure, the claim language is definite when read in light of the disclosure. Accordingly, model answer C is correct and petitioner’s answer E is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 9 reads as follows:

9. An applicant’s claim stands rejected under 35 U.S.C. § 103 as being obvious over Larry in view of Morris. Larry and Morris are references published more than one year before applicant’s effective filing. Although the examiner cites no suggestion or motivation for combining the references, they are, in fact, combinable. Which of the following arguments could properly show that the claim is not obvious?

- (A) The inventions disclosed by Larry and Morris cannot be physically combined.
- (B) Neither Larry nor Morris provides an express suggestion to combine the references.
- (C) As recognized by businessmen, the high cost of Larry’s device teaches away from combining it with the simpler device of Morris.
- (D) Absent a suggestion or motivation, the examiner has not shown that combining Larry’s with Morris’s device would have been within the level of ordinary skill of the art.
- (E) None of the above.

9. The model answer: (D) is correct. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also

suggests the desirability of the combination.” MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). Here, the examiner fails to show that substituting Larry’s device for another type of device in Morris would have been desirable. (A) is incorrect. The test of obviousness is not whether the features or elements of the references are physically combinable. *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983). (B) is incorrect. “The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.” MPEP § 2144 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)). Here, the argument overlooks the fact that a suggestion to combine Larry and Morris may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. (C) is incorrect. “The fact that a combination would not be made by businessmen for economic reasons does not mean that a person of ordinary skill in the art would not make the combination because of some technological incompatibility.” MPEP § 2145 (citing *In re Farrenkopf*, 713 F.2d 714, 718, 219 USPQ 1, 4 (Fed. Cir. 1983)). Here, the high cost of Larry’s device does not teach away from a person of ordinary skill in the art combining it with Morris’ device.

Petitioner argues that answer (B) is correct. Petitioner contends that all the answers should be thrown out since the question is confusing because the questions states that the references are combinable.

Petitioner’s arguments have been fully considered but are not persuasive. Contrary to petitioner’s statement that the question is confusing, the mere fact that the references can be combined or modified does not make the combination rejection obvious. Unless the prior art suggests the desirability of the combination, the combination of references would not be considered obvious to one of ordinary skill in the art at the time of the invention. Accordingly, the question is not considered confusing. Moreover, as to petitioner’s answer choice (B), the mere argument that neither of the references expressly suggest combining the references is not sufficient to show that the claim is not obvious. There is no requirement that the reference expressly state the reason to combine, rather it may be implied, generally available to one of ordinary skill in the art, or established by legal precedence. Accordingly, answer choice (B) is not a correct answer. On the other hand, if the combination does not have a suggestion or motivation to combine, then such argument could properly show that the claim is nonobvious. Answer choice (D) is an accurate statement.

Accordingly, model answer D is correct and petitioner’s answer B is incorrect.

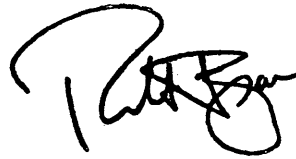
No error in grading has been shown. Petitioner’s request for credit on this question is denied.

ORDER

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read "Robert J. Spar", is positioned above a horizontal line.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy